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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,900	09/11/2003	Xinggao Fang	5668	4186

7590 08/18/2006

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/659,900	Applicant(s) FANG ET AL.	
	Examiner Anthony J. Green	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,24,25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,24,25 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the arguments submitted on 05 July 2006.

Claims 7, 24-25 and 29-34 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 24-25, and 29-34 rejected under 35 U.S.C. 103(a) as being obvious over Kimbrell Jr. et al (US Patent Application Publication No. 20040137814A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

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in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The reference teaches, in paragraph [0029] - [0032] the treatment of a textile substrate with a composition comprising a hydrophilic stain release agent, a hydrophobic stain repellency agent and a hydrophobic cross-linking agent. According to paragraph [0051] the hydrophilic stain release agent includes UNIDYNE® TG-992, REPEARL® SR1100 and ZONYL®7910. The hydrophobic stain repellency agent may be waxes, fluoropolymer, silicones etc. (paragraph [0052]).

The instant claims are obvious over the reference. The reference provides the motivation to produce a composition that encompasses the instant claims. It is the position of the examiner that some of the examples of the hydrophilic stain release agents would meet both component (b) and (c) as some of the listed trademarked stain release agents are believed to be fluorochemicals that possess urethane groups absent evidence showing otherwise. Note that the instant specification recites that one chemical component may serve as 2 components. As for the fluorine containing repellent component the reference suggests the use of fluoropolymers thus rendering obvious claims 7 and 34. As for claims 24-25 these claims are believed to be met by the reference as the reference suggests the use of repellent compounds that possess some of the claimed components. The same holds true for claims 29-31. With respect to claim 32 since one compound meets 2 components it is believed that only 3 ratios would be present and these amounts are encompassed by the amounts of the

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reference absent evidence showing otherwise. As for claim 33 the addition of one or other components is recited in paragraph [0069] of the reference wherein the components may be added simultaneously with the other treatment components.

4. Claims 7, 24-25, and 29-34 are rejected under 35 U.S.C. 103(a) as being obvious over Kimbrell Jr. et al (US Patent Application No 6,899,923 B2).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The reference teaches, in column 6, lines 65 - column 7, line 10, the treatment of a textile substrate with a composition comprising a hydrophilic stain release agent, a

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hydrophobic stain repellency agent and a hydrophobic cross-linking agent. According to column 8, lines 31-45 the hydrophilic stain release agent includes UNIDYNE® TG-992, REPEARL® SR1100 and ZONYL®7910. The hydrophobic stain repellency agent may be waxes, fluoropolymer, silicones etc. (column 8, lines 46+).

The instant claims are obvious over the reference. The reference provides the motivation to produce a composition that encompasses the instant claims. It is the position of the examiner that some of the examples of the hydrophilic stain release agents would meet both component (b) and (c) as some of the listed trademarked stain release agents are believed to be fluorochemicals that possess urethane groups absent evidence showing otherwise. Note that the instant specification recites that one chemical component may serve as 2 components. As for the fluorine containing repellent component the reference suggests the use of fluoropolymers thus rendering obvious claims 7 and 34. As for claims 24-25 these claims are believed to be met by the reference as the reference suggests the use of repellent compounds that possess some of the claimed components. The same holds true for claims 29-31. With respect to claim 32 since one compound meets 2 components it is believed that only 3 ratios would be present and these amounts are encompassed by the amounts of the reference absent evidence showing otherwise. As for claim 33 the addition of one or other components is recited in column 11, lines 62+ of the reference wherein the components may be added simultaneously with the other treatment components.

5. Claims 7, 24-25, and 29-34 are rejected under 35 U.S.C. 103(a) as being obvious over Kimbrell Jr. et al (US Patent Application Publication No. 20040138083A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The reference teaches, in paragraph [0031] - [0034] the treatment of a textile substrate with a composition comprising a hydrophilic stain release agent, a hydrophobic stain repellency agent and a hydrophobic cross-linking agent. According to paragraph [0053] the hydrophilic stain release agent includes UNIDYNE® TG-992, REPEARL® SR1100 and ZONYL®7910. The hydrophobic stain repellency agent may be waxes, fluoropolymer, silicones etc. (paragraph [0054]).

The instant claims are obvious over the reference. The reference provides the motivation to produce a composition that encompasses the instant claims. It is the position of the examiner that some of the examples of the hydrophilic stain release agents would meet both component (b) and (c) as some of the listed trademarked stain release agents are believed to be fluorochemicals that possess urethane groups absent evidence showing otherwise. Note that the instant specification recites that one chemical component may serve as 2 components. As for the fluorine containing repellent component the reference suggests the use of fluoropolymers thus rendering obvious claims 7 and 34. As for claims 24-25 these claims are believed to be met by the reference as the reference suggests the use of repellent compounds that possess some of the claimed components. The same holds true for claims 29-31. With respect to claim 32 since one compound meets 2 components it is believed that only 3 ratios would be present and these amounts are encompassed by the amounts of the reference absent evidence showing otherwise. As for claim 33 the addition of one or other components is recited in paragraph [0072] of the reference wherein the components may be added simultaneously with the other treatment components.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 7, 24-25, and 29-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-15 of copending Application No. 10/339,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the claims of the copending application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application are seen to encompass the instant claims.

8. Claims 7, 24-25, and 29-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/340,300. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to

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practice of the claims of the copending application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application are seen to encompass the instant claims.

9. Claims 7, 24-25 and 29-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 10/685,318 (US Patent Application Publication No. 20050062010A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the claims of the copending application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application are seen to encompass the instant claims.

10. Claims 7, 24-25, and 29-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,899,923 B2. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the reduction to practice of the claims of the prior patent would render obvious the instant claims.

The claims of the prior patent application are seen to encompass the instant claims.

Response to Arguments

11. Applicant's arguments filed 05 July 2006 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the 103(a) rejections are not persuasive as The rejections under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). These rejections might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to the 103 rejection, applicants simple statement that the references are commonly owned is not a proper showing of common ownership (see above). With respect to the arguments concerning the obviousness type double patenting rejections applicant's arguments are not persuasive as applicant is arguing that the claims are not anticipated by the references which is clearly incorrect as it should be noted that obviousness-type double patenting concerns obviousness not anticipation. As for the references not specifically teaching all of the claimed components it is the position of the examiner that one component of the references can meet 2 of applicants recited components absent evidence to the contrary and applicant has not provided any evidence to the contrary showing that this is not the case. Accordingly in order to overcome the instant rejections a proper showing must be provided along with terminal disclaimers.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

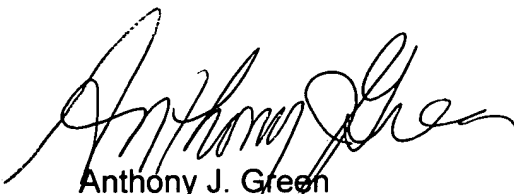
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
August 14, 2006